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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/576,297	05/23/2000	Makoto Misaka	865.4477	3752

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EXAMINER

CHOI, WILLIAM C

ART UNIT	PAPER NUMBER
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2873

DATE MAILED: 05/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/576,297

Applicant(s)

MISAKA, MAKOTO

Examiner

William C. Choi

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.


- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above claim(s) 18-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 61-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.


Loha Ben
Primary Examiner

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 5/23/2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

This application contains claims 18-60 drawn to an invention nonelected with traverse in Paper No. 10. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Specification

The amendment filed on March 6, 2003, is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: on page 4, lines 8, 10, 24 and 26; page 7, lines 26 and 28; page 20, lines 11 and 14; page 23, lines 6 and 9, applicant has introduced new matter into the disclosure, specifically, "<52" and "<60" have been changed to "≤52" and "≤60" respectively.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 1 (and dependent claims 3-17, 67, 68 and 71), 61-66, 69 and 70 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, in lines 8, 10, 21 and 23 of claim 1; lines 5 and 7 of claim 2; lines 8 and 10 of claims 61-66; lines 4 and 5 of claim 69; "<52" and "<60" have been changed to "≤52" and "≤60" respectively, which was not disclosed in the original specification. In line 2, applicant adds the limitation, " $1.15 < |f_1/f_2| < 1.45$ ", which was not disclosed in the originally filed specification. Claims 3-17, 67, 68 and 71 inherit the rejection based on their dependency on claim 1.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 69 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, applicant claims wherein "v1n" satisfies the claimed conditions without specifying what "v1n" is referring to, therefore rendering the claim vague and indefinite. For purposes of examination, "v1n" was assumed to be "v11n" based on the claim's dependency on claim 1 where "v11n" is disclosed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 9, 10, 13, 69 rejected under 35 U.S.C. 102(b) as being anticipated by Nose et al (Japanese Patent Publication 5-297276).

In regards to claim 1, Nose et al discloses a zoom lens (English abstract, Figure 1) comprising, in order from an object side to an image side, a first lens unit of negative refractive power (Figure 1, "1"), a second lens unit of positive refractive power (Figure 1, "2"), a third lens unit of negative refractive power (Figure 1, "3"), and a fourth lens unit of positive refractive power (Figure 1, "4"), wherein said first lens unit has a negative lens located on the most object side thereof (Figure 1, "R1"), and said negative lens located on the most object side of said first lens unit satisfies the claimed conditions (column 7, line 9) and wherein said first lens unit has a second negative lens other than said negative lens located on the most object side thereof (Figure 1, "R5"), and said second lens satisfies the claimed conditions (column 7, line 13).

Regarding claim 9, Nose et al discloses wherein said fourth lens unit satisfies the claimed condition (column 7, lines 4 and 36).

Regarding claim 10, Nose et al discloses wherein said second lens unit comprises two positive lenses and one negative lens (Figure 1, "2").

Regarding claim 11, Nose et al discloses wherein said third lens unit comprises a cemented lens composed of a negative lens and a positive lens (Figure 1, "3").

Regarding claim 13, Nose et al discloses wherein said second lens unit comprises one positive lens and a positive cemented lens composed of a negative lens and a positive lens (Figure 1, "2").

Regarding claim 16, the zoom lens of Nose et al would inherently be comprised in an image pickup apparatus, comprising a photosensitive member and means for supporting said zoom lens and said photosensitive member, this being reasonably assumed from Nose et al disclosing his invention to be used on an optical system of a data exhibiting device (English Abstract).

Regarding claim 17, the zoom lens of Nose et al would inherently be comprised in an image projection device comprising a light source and an image forming element and arranged to project an image, this being reasonably assumed from Nose et al disclosing his invention to be used on an optical system of a data exhibiting device (English Abstract).

Regarding claim 69, Nose et al discloses wherein the conditions regarding v11n are satisfied (column 7, line 9).

Allowable Subject Matter

No decision regarding allowable subject matter can be made at this time due to the introduction of new matter in this application.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Choi whose telephone number is (703) 305-3100. The examiner can normally be reached on Monday-Friday from about 9:00 am to 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on (703) 308-4883. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3431 for regular communications and (703) 305-3432 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

W.C

William Choi
Patent Examiner
Art Unit 2873
May 21, 2003



Loha Ben
Primary Examiner